

AMENDMENTS TO THE DRAWING:

The attached sheet of drawing includes changes to Fig. 1. This sheet replaces the original sheet. In Fig. 1, previously omitted element 104 has been added.

Attachment: Replacement Sheet

REMARKS

Claims 1-19 are pending in this application. Claims 1, 4, 5 and 19 have been amended. Claims 4 and 5 have been amended to remove the lack of antecedent basis.

Claims 1-10, 12-19 were rejected under 35 USC §103(a) as being unpatentable over Foth (Application No. 2003/0068045) in view of McGarvey et al. (Application No. 2003/0028773). Claim 11 was rejected under 35 USC §103(a) as being unpatentable over Foth in view of McGarvey et al. and further in view of Taniguchi et al. (U.S. Patent No. 6,801,962).

Claim 1, as amended, claims in a client-server-document repository system, a secure method for remote action by reference, comprising: sending, from the client to the server, user credentials pertaining to a document stored in the document repository, a delegation credential giving permission to the server to obtain the document and permitting the server to perform an action on the document on the user's behalf and the address of the document in the document repository; verifying, at the server, the user's credentials and the delegation credential; if verified, sending, from the server to the document repository, server credentials, the delegation credential and the address of the document; verifying, at the document repository, the server's credentials and the delegation credential; if verified, sending the document from the document repository to the server; and performing the action on the document at the server.

Foth does not teach or suggest secure print/action by reference; Foth teaches printing using the IPP. Foth teaches secure printing where the client 22 uses a secure device (adapter 30) to obtain a document from a document repository and the adapter sends the document securely to a server (printer). In Foth, adapter 30 communicates with the data center 12 and obtains the document 14, which it sends to a printer 20 (either directly or through a personal computer 40). Printer 20 does not communicate directly with data center 12. "If the documents 14 are not to be encrypted, then in step 66 the data center 12 translates the print request to a network based printing protocol print request, such as, for example, an Internet Printing Protocol request, for the target printer 20 and sends the requested documents 14 to the printer 20 via the Internet 18 through adapter 30." (See paragraph 24 of Foth.)

Adapter 30 provides any required security when obtaining documents directly from data center 12. If the document is encrypted, adapter 30 decrypts it prior to sending it to printer 20. "In step 74, the adapter 30 decrypts the documents 14 and sends the decrypted documents 14 to printer 20. (See paragraph 25 of Foth.)

In contrast, Applicants' Claim 1, claims, in part: "sending, from the server to the document repository, server credentials, the delegation credential and the address of the document; verifying, at the document repository, the server's credentials and the delegation credential; if verified, sending the document from the document repository to the server". In Applicants' method, the server (which may be a printer) communicates directly with the document repository and receives the document directly from the document repository. Sending the address of the document eliminates the need for retrieving a document to a client and sending it securely to a printer especially if the client cannot hold large documents (for example, a hand held PC or PDA) or is not capable of holding electronic documents (for example, a facsimile machine).

There is no teaching to combine McGarvey with Foth. Foth teaches away from a delegation credential. While McGarvey teaches methods for secure delegation using public key authentication, there is no suggestion or teaching to combine McGarvey with Foth. Indeed, Foth teaches away from the use of a delegation credential since Foth uses adapter 30 to provide secure communication and receipt of documents. "Adapter 30 is preferably a portable device that a user can carry with him and attach to any printer 20 utilizing standard Ethernet connections. Alternatively, an adapter 30 may be provided externally or internally to printer 20 for general use by any user." (See paragraph 20 of Foth.)

The Examiner suggests that the middle-tier server of McGarvey as applied to Foth can be considered the printer with the built in adaptor. Applicants submit that this suggestion by the Examiner comes from a reading of Applicants' claims and not from a reading of Foth or McGarvey. There is clearly no need in Foth for any delegation credentials. The user in Foth communicates directly with the document repository (through the adaptor 30) and directly with

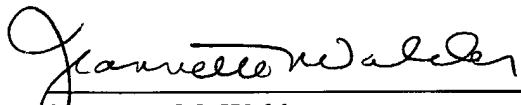
the printer (through adaptor 30). The user in Foth provides the user's credentials to the adapter, which communicates directly with the document repository. "In step 54, the user establishes a communication with the adaptor 30 via a mobile device 22 and passes information, such as, for example, the user's identity and password to adaptor 30. . . . In step 56, adaptor 30, utilizing the information sent from mobile device 22, communicates with data center 12 via the Internet 18 and retrieves a list of documents." (See paragraph 23 of Foth.) Any documents sent by data center 12 of Foth are sent to adaptor 30 before going to a printer. Even when adaptor 30 is connected to a personal computer (see Fig. 7), documents are downloaded to the personal computer/adaptor for printing to the printer. In Foth, there are no middle tier servers; all servers (data center and printer) can be considered back end servers (in the parlance of McGarvey).

Applicants believe that Claims 1-19 are in condition for allowance.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

Reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is requested to call the undersigned Attorney for Applicants, Jeannette Walder.

Respectfully submitted,



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Xerox Corporation
Santa Ana, California
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